



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

AFW
JFW

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

NG(MS)7178NP

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

On 1 September 2005

Signature Lisa L. Pringle

Typed or printed
Name Lisa L. Pringle

Application Number
09/690,544

Filed
16 Oct. 2000

First Named Inventor
Kenneth W. Aull

Art Unit
2134

Examiner
V. Perungavoor

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.

Registration No. 43,660

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Christopher P. Harris
Signature

Christopher P. Harris

Typed or printed name

(216)621-2234

Telephone number

1 September 2005

Date

Note: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 C.F.R. 1.1, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, CA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PRE-APPEAL REQUEST FOR REVIEW SUMMARY

Claims 1-66 are currently pending in the subject application, and are presently under consideration. Claims 1-21, 26-28, 32-52, 57-59 and 63-66 are rejected. Favorable reconsideration of the application is requested in view of the amendments and comments herein.

I. The Rejection of Claims 11-14, 16-22, 24-28, 42-45, 47-51-53, 55, 57-59, and 63-66 Under 35 U.S.C. §102(e) Was Made in Error

Claims 11-14, 16-21, 26-28, 42-45, 47-52, 57-59, and 63-66 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,301,658 to Koehler ("Koehler") in the Final Office Action dated May 3, 2005 ("Office Action"). It is respectfully submitted this rejection was made in error.

Claims 11 and 42 recite elements that are to be performed to/for a role certificate, such that the role certificate can be utilized by a user that is a member of a group as a group stamp and for encryption of information which may be decrypted by a plurality of group members. Koehler at no point discusses the use of a role certificate that can be utilized as a member of a group authorized to utilize the role certificate as a group stamp and for encryption of information which may be decrypted by a plurality of group members, as recited in claim 11. In the Response to the Final Office Action of May 3, 2005 ("Final Response"), on pages 2-3 Applicant clearly sets forth as to why Koehler fails to meet this element of claims 11 and 42. Specifically, the section of Koehler cited in the Office Action discloses a process to implement a certificate revocation list (CRL) (See Koehler, Col. 3, Lines 1-33 and Col. 4, Lines 23-32). The section of Kohler cited in the Office Action discloses nothing that can be construed as a role certificate, as recited in claims 11 and 42. The additional section of Kohler cited in the Advisory Action dated July 12, 2005 ("Advisory Action") also does not disclose a role certificate (See Koehler, Col. 5, Lines 21-41). The section of Kohler cited in the Advisory Action discloses a process for validating a digital certificate using a CRL, but offers nothing that could be construed as the role certificate recited in claims 11 and 42 that can be utilized by a group member as a group stamp and for encryption of information which may be decrypted by a plurality of group members. Accordingly, Koehler does not disclose each and every element of claims 11 and 42, and thus, the rejection of claims 11 and 42 was made in error.

Claims 16, 21, 28, 52 and 59 recite that a role certificate comprises (among other things), extensions and at least one policy. Claim 16 depends from claim 11, claim 21 depends from

claim 17, claim 24 depends from claim 22, claim 28 depends from claim 26, claim 52 depends from claim 48, claim 55 depends from claim 53, and claim 59 depends from claim 57. In the Final Response, Applicant sets forth reasons showing that Koehler does not meet the elements of claims 16, 21, 28, 52, and 59 (See Final Response Pages 5-6). Specifically, the sections of Koehler cited in the Office Action discloses that a verification server maintains a verification cache for each authenticated digital certificate that stores user privileges (See Koehler, Col. 5, Line 63-Col. 6, Line 9). Nothing in Koehler discloses that policies are stored on a digital certificate of any type (and particularly not on a role certificate). Thus, Koehler does not disclose each and every element of claims 16, 21, 28, 52 and 59. Thus, the rejection of these claims was made in error.

Claims 17 and 48 recite a method and computer program, respectively, of revoking a role certificate used as an organizational stamp and for organizational encryption by authorized members of the organization comprising transmitting a signature certificate to a registration web server by a user, wherein the user is a member of a group authorized to utilize the role certificate as a group stamp and for encryption of information which may be decrypted by a plurality of group members. As described above with regard to claims 11 and 42, Koehler does not teach the use of a role certificate, and thus, the rejection of claims 17 and 48 was made in error.

Claims 26 and 57 recite a method of revoking a role certificate and an associated role by a role administrator comprising transmitting a request to revoke the role certificate of a role member, wherein the role member is a member of a group authorized to utilize the role certificate as a group stamp and for encryption of information which may be decrypted by a plurality of group members. As described above with regard to claims 11 and 42, Koehler does not disclose the use of a role certificate, as recited in claims 26 and 57. Additionally, in the Final Response, Applicant set forth reasons that the sections of Koehler in the Office Action does not disclose claims 26 and 57 (See Final Response, Pages 10-12). Specifically, the sections of Koehler cited in the Office Action disclose authentication by utilizing time stamps (See Koehler, Col. 4, Lines 23-32), and searching a CRL (See Koehler, Col. 8, Lines 26-31). However, Koehler does not disclose searching a database for all role certificates in which a role

administrator is listed as a role administrator. Thus, Koehler does not disclose each and every element of claims 26 and 57. Accordingly, the rejection of claims 26 and 57 was made in error.

Claim 63 recites a role certificate for organizational encryption and for use as an organizational stamp or seal comprising extensions having a plurality of bits which designate characteristics associated with the role certificate, wherein when a bit for encryption is set and a bit for signature is set, the role certificate may be used for both digital signatures and encryption, and a policy defining the limitations on valid usage of the role certificate. Applicant set forth reasons that the sections of Koehler in the Office Action does not disclose claim 63 (See Final Response, Pages 10-12). Specifically, as stated above with respect to claim 11, Koehler does not disclose a role certificate that contains a policy defining limitations on valid usage of the role certificate, as recited in claim 63. Thus, Koehler does not disclose each and every element of claim 63. Accordingly, the rejection of claim 63 was made in error.

For the reasons described above, claims 11-14, 16-21, 26-28, 42-45, 47-52, 57-59, and 63-66 were wrongfully rejected. Accordingly, withdrawal of this rejection is respectfully requested.

II. The Rejection of Claims 1, 3-9, 32, and 34-40 Under 35 U.S.C. §103(a) Was Made in Error

Claims 1, 3-9, 32, and 34-40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,308,277 to Vaeth, et al. ("Vaeth") in view of U.S. Patent No. 5,659,616 to Sudia ("Sudia"). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Claims 1 and 32 recite a method and a computer program, respectively, of creating a role certificate comprising transmitting a role approval form, filled out and digitally signed by the user using a personal digital signature, wherein the user is a member of a group authorized to utilize the role certificate as a group stamp and for encryption of information which may be decrypted by a plurality of group members. It is respectfully submitted that the Office Action fails to establish a prima facie case of obviousness with respect to claims 1 and 32. The cited section of Vaeth discloses a generic digital certificate issued by a certificate authority ("CA") (See Vaeth, Col. 3, Lines 35-47). Sudia discloses that group and role certificates may be used in

conjunction with a cosignature mechanism (See Sudia, Col. 7, Lines 25-34). However, neither Vaeth nor Sudia teaches or suggests a role certificate that can be utilized as *both* a group stamp and for encryption of information which may be decrypted by a plurality of group members. Accordingly, taken individually or in combination, Vaeth and Sudia fail to teach or suggest each and every element of claims 1 and 32. Thus, the Office Action has failed to establish a prima facie case of obviousness, with respect to claims 1 and 32.

Claims 7 and 38 recite a method and computer program, respectively, of using a role certificate as an organizational stamp and for organizational encryption by a plurality of role members of a group comprising signing digitally the electronic form by the role member using the role certificate and signing digitally the electronic form by the role member using a personal signature certificate, wherein the role member is a member of a group authorized to utilize the role certificate as a group stamp and for encryption of information which may be decrypted by a plurality of group members. As described above with regard to claims 1 and 32, the combination of Vaeth and Sudia does not teach or suggest the use of a role certificate, and thus the Office Action has not established a prima facie case of obviousness regarding claims 7 and 38.

Claims 8 and 39 recite retrieving a policy associated with the role certificate by the entity. Claim 8 depends from claim 7, and claim 39 depends from claim 38, and thus both should be patentable for at least the reasons described above regarding claims 7 and 38. Applicant has set forth reasons in the Final Response that Vaeth and Sudia, taken alone or in combination do not establish a prima facie case of obviousness regarding claims 8 and 39 (See Final Response, Page 16).

Dependent claims 9 and 40 recite transmitting a public key portion of the role certificate by the role member to the entity, encrypting information by the entity, transmitting the information to any of the plurality of role members of the group, and decrypting the information by any of the plurality of role members of the group having the role certificate. The Final Response sets forth the reasons that Vaeth and Sudia, taken alone or in combination do not establish a prima facie case of obviousness regarding claim 9 and 40 (See Final Response Pages 16-17). Specifically, Vaeth does not teach or suggest a role certificate that can be utilized to

decrypt information by any of a plurality of role members of a group having the role certificate, as recited in claims 9 and 40.

III. The Rejection of Claims 2, 10, and 33 Under 35 U.S.C. §103(a) Was Made in Error

Claims 2, 10, and 33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Vaeth in view of U.S. Patent No. 6,275,859 to Wesley, et al. ("Wesley"). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Dependent claims 2, 10, 33, and 41 recite that the role certificate comprises a public key, a private key, a signature algorithm ID, a validity period, extensions, and at least one policy. Wesley does not teach the use of a role certificate, such that the addition of Wesley does not cure the deficiencies of Vaeth. Applicant sets forth reasons that Vaeth in view of Wesley do not establish a prima facie case of obviousness with respect to claims 2, 10, 33 and 41. Specifically, Wesley discloses that a participation certificate contains a digital signature, a public key, starting and ending times for a period of authorized participation, and an identifier of a role that a node may play in a multicast session (See Wesley, Col. 4, Lines 18-27). However, Wesley does not teach or suggest that the participation certificates contain extensions or at least one policy, like the role certificates recited in claims 2, 10, 33 and 41. Thus, Vaeth and Wesley taken alone or in combination do not teach or suggest each and every element of claims 2, 10, 33 and 41. Accordingly, the Office Action has failed to establish a prima facie case of obviousness regarding claims 2, 10 and 33 and 41.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully submits that the present application is in condition for allowance. Applicant respectfully requests reconsideration of this application and that the application be passed to issue.

Please charge any deficiency or credit any overpayment in the fees for this response to our Deposit Account No. 20-0090.